

U.S.S.N.: 10/003,986
Reply to Office Action dated November 18, 2003
Attorney Docket No. 10541-449

II. Remarks/Arguments

Claims 1, 3-8, 10-26, and 28-39 presently stand rejected on the basis of prior art. Reconsideration and further examination of claims 1, 3-8, 10-26, and 28-39 in light of the following arguments is respectfully requested.

Rejections Under 35 USC §103 – Part One

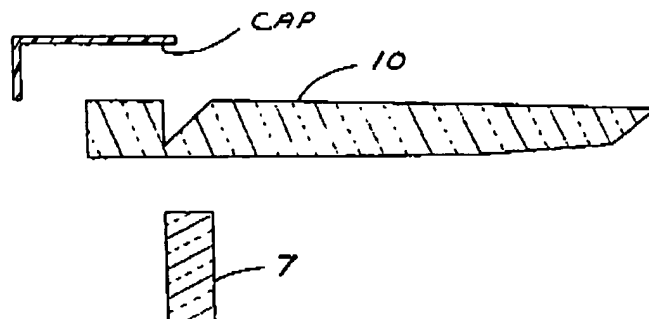
The Examiner rejected Claims 1, 3-7, 10, 12, 13, 21-25, 28, 30, 31, and 39 under 35 USC §103(a) as being unpatentable over United States Patent No. 6,004,001 issued to Noll (Noll) in view of United States Patent No. 5,703,612 issued to Salmon et al. (Salmon) and United States Patent No. 4,274,358 issued to Nakamura (Nakamura).

The Applicants respectfully assert that Noll in view of Salmon and Nakamura does not teach each and every element of the invention as claimed in independent claims 1 and 22.

The Examiner states that Noll discloses "an instrument pointer illuminating apparatus comprising an instrument pointer (6) with a hub (X, see figure in office action) with a top and bottom and a spindle/light guide (7) mounted to said bottom surface of said hub portion adapted to propagate light from said light sources upward into said pointer..."

The Applicants respectfully disagree with this analysis of Noll, and submit the following exploded view of the instrument pointer of Noll to illustrate this argument:

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Noll includes a needle portion 10, a spindle/light guide 7, and a cap (not numbered in the Noll patent). The Examiner uses a capital letter X with an arrowhead leader generally indicating the entire Figure 3 of Noll as a "hub". The Applicants assert that Noll includes a cap mounted onto the needle portion 10 and a spindle/light guide mounted onto the bottom of the needle portion. Noll does not include "a hub with a top surface and a bottom surface", as disclosed in claims 1 and 22 of the present application. Therefore, the Applicants further assert that Noll in view of Salmon and Nakamura does not disclose "a hub with a top surface and a bottom surface and a needle portion and a light reflecting portion mounted onto said top surface of said hub, said light reflecting portion being flared outward from said needle portion ...; and a light guide mounted to said bottom surface of said hub portion adapted to propagate light from said light sources upward into said instrument pointer".

For these reasons, the Applicants assert that claims 1 and 22 are patentable over Noll in view of Salmon and Nakamura. The Applicants further assert that claims 3-7, 10, 12, 13, 21, 23-25, 28, 30, 31, and 39 are allowable as depending, either directly or indirectly, from allowable independent claims 1 or 22. Accordingly, the

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Applicants respectfully request that the Examiner reconsider and withdraw these rejections under 35 USC §103(a).

With regard to claim 12, the Examiner states that Nakamura discloses a reflector around the motor shaft that reflects light upward into the pointer. The Applicants respectfully point out that reference numeral 19 of Nakamura is a recess, or void. There is no object at that position. Accordingly, the Applicants respectfully assert that Nakamura does not include a light reflector as claimed in claim 12 of the present application. Therefore, the Applicants respectfully request that the Examiner reconsider and withdraw this rejection under 35 USC §103(a), with regard to claim 12.

Rejections Under 35 USC §103 – Part Two

The Examiner rejected Claims 14-20, and 32-38 under 35 USC §103(a) as being unpatentable over Noll, Salmon, and Nakamura further in view of United States Patent No. 5,521,725 to Beeson et al. (Beeson).

The Examiner states that "Beeson disclosed an illumination system employing an array of microprisms that uses an astigmatic lens (80) (col. 7 lines 37-39). Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to add astigmatic lenses disclosed by Beeson et al. to the light collector disclosed by Noll, Salmon and Nakamura et al. in order that the light path will be better directly focused".

The Applicants respectfully disagree with this analysis, and assert that there is no motivation, within the references, to combine the teachings of Noll, Salmon, and Nakamura with Beeson.

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Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion, or incentive supporting the combination. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d. 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984).

The mere fact that references can be combined or modified does not render the resultant combination obvious, unless the prior art also suggests the desirability of the combination. *In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1318 (Fed. Cir. 2000).

The Applicants respectfully assert that the Examiner has impermissibly used "hindsight" by using Applicant's teaching as a blueprint to hunt through the prior art for the claimed elements and combine them as claimed. The Applicants assert that there is no suggestion for the combination in either the combination of Noll, Salmon, and Nakamura, or in Beeson. Accordingly, the Applicants respectfully request that the Examiner reconsider and withdraw these rejections under §103(a).

Rejections Under 35 USC §103 – Part Three

The Examiner rejected Claims 8 and 26 under 35 USC §103(a) as being unpatentable over Noll, Salmon, and Nakamura further in view of United States Patent No. 5,878,689 issued to Sugita (Sugita) and United States Patent No. 5,291,851 issued to Muramatsu (Muramatsu).

In light of the arguments made above, the Applicants assert that claims 8 and 26 are allowable as depending, either directly or indirectly, from allowable independent claims 1 and 22 respectively. Accordingly, the Applicants respectfully request that the Examiner reconsider and withdraw these rejections under §103(a).


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Conclusion

The Applicants assert that pending Claims 1, 3-8, 10-26, and 28-39, as amended are patentable. Applicants respectfully request the Examiner grant allowance of these claims. The Examiner is invited to contact the undersigned attorneys for the Applicants via telephone if such communication would expedite this application.

Respectfully submitted,

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